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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,389	11/25/2003	Masahiko Hatanaka	MAT-8475US	1655
23122	7590	12/02/2008	EXAMINER	
RATNERPRESTIA P.O. BOX 980 VALLEY FORGE, PA 19482				DANG, DUY M
ART UNIT		PAPER NUMBER		
2624				
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12/02/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/721,389	HATANAKA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Duy M. Dang	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 November 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09 January 2008 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/22/08</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

1. Applicant's amendment filed on 11/13/2008 has been entered and made of record.

Currently, claims 1-15 are pending.

### ***Response to Arguments***

2. Applicant's arguments, see page 5 of the response/reply filed on 11/13/2008, with respect to the rejection of claims 1-15 under 35 USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as follows.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7-10 and 14-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 14-15, it is noted that these apparatus claims depend from a method claim 7. Thus, these claims are not either method claims or apparatus claims, they fail to meet the requirements set forth in 35 USC 101 (process, machine, manufacture, or composition of matter.)

Regarding claims 7-10, these method claims are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent (See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008))

indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claims recite a series of steps or acts to be performed, the claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. Suggestion to make claim 7, for example, to be statutory as follows:

“A method of compressing image data comprising:  
receiving image data to be compressed;  
using a processor (or computer) to perform the steps of: compressing image data...second compression rate.”

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitations of "said plurality of approximate expression" in lines 6-7 and 9, "said first approximate expression" in line 7, and "said plurality of different sample data sizes" in lines 8-9 are insufficient antecedent basis.

Claim 2 recites the limitation "said plurality of approximate expression" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "said plurality of different sample data sizes" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "said plurality of approximate expressions" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "said plurality of approximate expressions" in line 2.

There is insufficient antecedent basis for this limitation in the claim

Likewise, claims 2-6 and 12-13 depend from claim 1 and thus are rejected for the same reasons.

Regarding claim 7, the limitations of "said plurality of different sample data sizes" in line 7 and "said plurality of approximate expressions" in line 9 are insufficient antecedent basis.

Claim 8 recites the limitation "the plurality of approximate expression" in lines 1-2.

There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the plurality of different sample data sizes" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "said plurality of approximate expressions" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "said plurality of approximate expressions" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

Likewise, claims 8-11 and 14-15 depend from claim 17and thus are rejected for the same reasons.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 6:00AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh M. Mehta can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dmd  
11/08

/Duy M Dang/  
Primary Examiner, Art Unit 2624